



**EXAMINING GROUP 1636  
EXPEDITED AFTER-FINAL PROCEDURE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Shea, Bonadio, Peters and Mooney

Serial No.: 09/442,542

Filed: November 18, 1999

For: SUSTAINED DNA DELIVERY FROM  
STRUCTURAL MATRICES

Group Art Unit: 1636

Examiner: Kaushal, S.

Atty. Dkt. No.: 4100.002000

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37 C.F.R. § 1.8**

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July 10, 2003

Date

*Shelley P.M. Fussey*  
Shelley P.M. Fussey

**REQUEST TO WITHDRAW PREMATURE FINALITY UNDER MPEP 706.07(d)  
AND REQUEST TO RESTART PERIOD FOR RESPONSE UNDER MPEP 710.06**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the holding of finality set forth in the third and originally Final Official Action ("the Third Action") dated June 10, 2003 be withdrawn in accordance with MPEP 706.07(d). The Third Action offered no reasoning to support the holding of finality. The finality of the Third Action was premature, as the Action entered a new ground of rejection against several claims, not necessitated by Applicants' amendment or untimely submission of references. Finality is therefore improper and should be withdrawn.

## **I. Prosecution History**

In the First Official Action, claims 1-68 were pending and examined. The First Action allowed claims 1-47 and 49-68. Claim 48 alone was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,933,185 to Wheatley *et al.* ("the Wheatley patent"). Applicants amended claims 1, 13, 48, 66 and 68 and added claims 102 and 103.

The Second Official Action re-examined claims 1-68, 102 and 103, and this time allowed claims 54-65 and indicated claims 14-16, 26-34, 38 and 39 to be allowable, but "objected to". The Second Action did not comment on the rejection of previously allowed claims 1-47 and 49-68. Claims 1-13, 17-25, 35-37, 40-53, 66-68, 102 and 103 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the Wheatley patent of record. Applicants amended claims 1-7, 13-15, 41-43, 45-51, 66, 68, 102 and 103 and added claims 114-117.

Prior to the Third Action, claims 1-68 and 102-117 were pending, many of which are unamended claims. The Third Action re-examines claims 1-68 and 102-117 and now rejects claims 1-12, 19-47, 49-53, 66-68 and 102-117 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,514,378 to Mikos *et al.*, U.S. Patent No. 5,639,473 to Grinstaff *et al.* and U.S. Patent No. 5,965,125 to Mineau-Hanschke in combination.

## **II. The Third Action is Prematurely Final**

The § 103(a) rejection in the Third Action is a new ground of rejection, not necessitated by Applicants' amendment or untimely submission of references. The Third Action offers no reasoning to support the holding of finality, which is itself contrary to proper procedure. Finality is premature as the § 103(a) rejection is newly applied to several non-amended claims and as the cited references were not submitted in an untimely manner by the Applicants.

### **III. Claim 52**

Although there are many aspects of the Third Action that render finality premature, Applicants elect to focus on claim 52 in order to simplify the issue. This is done without acquiescing with proper finality as to any other claim.

Claim 52 is subject, for the first time, to the foregoing § 103(a) rejection over the three patents newly cited by the Office. As claim 52 is an unamended, independent claim, this is clearly a new ground of rejection not necessitated by Applicants' amendment or untimely submission of references. The final rejection of claim 52, just as one example, is therefore improper and Applicants respectfully request that the holding of finality be withdrawn.

### **IV. Restart Period for Response**

The Third Action is defective in being prematurely final, as set forth above. Applicants submit that this is a defect warranting the Office to restart the period for response. Applicants therefore respectfully request that the period for response be re-started with the mailing of a non-Final Action, which corrects the earlier error of premature finality. The present Request is being filed within one month of the mail date of the Third Action, as required by MPEP 710.06. Restarting the period for response is therefore proper. No fees are required in connection with this request.

### **V. Conclusion**

Finality of the Third Action is premature and must be withdrawn. The period for response should also be re-set to run from the mailing of a non-Final Action.

According to MPEP 706.07(d), the present document need only be a Request and not a Petition (although Applicants reserve the right to challenge any adverse holding by petitioning the Group Director under MPEP 706.07(c) and 1002.02(c)).

No fees are due for Requests under MPEP 706.07(d) or MPEP 710.06. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason, the Assistant Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/4100.002000. Applicants reserve the right to request a refund for any fees deducted in connection with this Request.

Should the Office have any questions, a telephone call to the undersigned Applicants' representative is earnestly solicited.



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PATENT TRADEMARK OFFICE

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Shelley'.

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Date: July 10, 2003